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Claims 1-15, 20, and 21 are pending in this application. The Examiner has rejected each pending Claim 35 U.S.C. §103.

Rejections Under 35 U.S.C. § 103

The Examiner rejected Claims 1-15, 20, and 21 under Section 103 citing U.S. Patent 6,012,890 issued to Celorio Garrido in light of a July 2000 article title "Pedal Pushers (Green Gear Cycling's manufacturing principles)". To establish a prima facie case of obviousness, the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; that there is a reasonable expectation of success; and that the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP § 2142 (*citing In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991)).

Claims 1-6 are directed to a book manufacturing method with each of Claims 2-6 depending from Claim 1. Garrido and the Pedal Pushers article fail to teach one or more limitations required by each of claims 1-6. Moreover, the Examiner has neglected show any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine and modify the teachings of Garrido and the Pedal Pushers article.

Claim1 requires the following limitations:

- a) receiving a dimension of a book storage space;
- b) selecting page and cover media according to the received dimension; and
- c) manufacturing a book using the selected page and cover media so that the book can be physically placed within the book storage space.

Rejecting Claim 1, the Examiner asserts that Garrido teaches a method for

manufacturing books where (1) the desired page size and book size is based on a customer's choice and (2) manufacturing the book at the desired choice size.

The Examiner admits that Garrido does not teach the receiving step required by Claim 1 and thus does not teach selecting page and cover media according to the received dimension.

Garrido discusses producing books in four sizes – those sizes being dictated by the sizes of commercially available sheets of paper. Col. 7, lines 29-46. By contrast, Claim 1 requires that a book be produced to fit in a book storage space – the production of the book being guided by a dimension of that storage space.

The Examiner asserts, however, that the Pedal Pushers article teaches those limitations of Claim 1 that Garrido does not. The Examiner contends that the Pedal Pushers article teaches:

the general concept of selective manufacturing item (bike) according to customer's weight, measurements and specifications which comprising the steps of (a) inherently receiving customer's measurement of the item (bike) storage space (car trunk, tight storage space, or suitcase for traveling on a plane), (b) preparing/designing the bike according to the received customer's measurement, and (c) manufacturing the item (bike) using the designed size to that the item (bike) can be physically fit or placed within the item storage space.

The Pedal Pushers article discusses the challenges facing and the successes achieved by a bicycle manufacturing company in Eugene, Oregon. According to the article, the company manufactures custom made folding bikes.

Pedal Pushers, para. 1. The article states: "The bike fits into a car trunk, a tight storage space, or an optional suitcase to travel on a plane like regular baggage. (The suitcase even can be converted into a trailer to haul gear.)"

Pedal Pushers, para. 1. The article notes that in the year 2,000, the company expected to "build about 2,000 bikes to customer weight, measurements, and equipment specifications, at an average selling price of \$1,700 including the optional case." Pedal Pushers, para. 4.

As noted, the article suggests that a bike can be built based on customer

measurements – height and weight. The article mentions that the bike may be sold with an optional suitcase. Nowhere in the Pedal Pusher article is it mentioned, implied, or suggested that a dimension of a storage space is received let alone a dimension of a book storage space as required by the first limitation of Claim 1. The article does not state, imply, or suggest that a dimension of the of a storage space is received and that an item is manufactured based on that dimension as required by the second and third limitations of Claim 1. }

Consequently, the combined teachings of Garrido and the Pedal Pusher article fail to teach all of the limitations required by Claim 1. Even if they did, there is no motivation to combine their teachings. Garrido is directed to the manufacture of books. The Pedal Pusher article, on the other hand, describes the history of a bicycle manufacturing company. For these reasons, Claim 1 as well as Claims 2-6 which depend from Claim 1, are felt to distinguish over the cited references.

Claim 2 further limits the manufacturing step of Claim 1 to require “manufacturing a set of books using the selected page and cover media so that the set of books can be physically placed within the book storage space.” The Examiner rejected Claim 2 asserting that Garrido and the Pedal Pushers article teach “the production of more that one item.” The Examiner’s assertion fails to address the requirements of Claim 2. Nowhere in Garrido or in the Pedal Pusher article is it mentioned, or suggested that a set of books or other items be manufactures such that the set can be physically placed in a book storage space having a specified dimension.

For these additional reasons, Claim 2 is felt to distinguish over the cited art.

Claim 3 further limits Claim 2 adding a step requiring that input be received that identifies each book in the set of books. The Examiner rejected this claims merely stating “this is fairly taught in page 1 of” the Pedal Pusher article. To the contrary, nowhere in the pedal pusher article does it mention or suggest the receipt of input identifying each book in a set of books.

For these additional reasons, Claim 3 is felt to distinguish over the cited

art.

Claim 6 adds a limitation requiring the provision of a purchase cost for the manufacturing of a set of books. The Examiner rejected this claims merely stating "this is taught in page 1 of" the Pedal Pusher article. To the contrary, nowhere in the pedal pusher article does it mention or suggest the provision of a purchase price for a set of books.

For these additional reasons, Claim 6 is felt to distinguish over the cited art.

Claims 7-11 are directed to a book manufacturing system with each of Claims 8-11 depending from Claim 7. Claim 7 requires the following limitations:

- a) an order placement system capable of receiving input identifying a book and a dimension of a book storage space and of selecting page and cover media according to the received dimension;
- b) a print module operable to use selected page media to print the pages of the book and to use selected cover media to print the cover of the book so that the book can be placed physically within the book storage space; and
- c) a finishing module operable to bind a printed cover and pages to produce a finished book.

In short, Claim 7 is directed to a system for performing the method steps of Claim 1. Rejecting Claim 7, the Examiner stated "it would have been obvious to a skilled artisan to set up a system ... to carry out the method steps as shown on claim1."

As noted above, Garrido and the Pedal Pushers article fail to teach one or more limitations required by Claim 1. Consequently, the cited references do not teach all the limitations required by Claim 7. Moreover, the Examiner has neglected show any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine and modify the teachings of Garrido and the Pedal Pushers article.

For these reasons, Claim 7 and Claims 8-11, which depend from Claim 7, are felt to distinguish over the cited art.

Claims 12-15, 20, and 21 are directed to a computer readable medium having instructions relating to the manufacture of a book. Claim 12 instructions for performing the method steps of Claim 1. The Examiner rejected Claim 12 citing Garrido, col. 2, line 65 to col. 3, line 30, col. 5 lines 40-67, col. 6, line 40 to col. 7, line 20.

Nothing in the cited section teaches computer readable instructions for receiving input defining a dimension of a book storage space, selecting paper and cover media according to that dimension, or directing the production of a book so that it can be stored within the book storage space having the specified dimension. When rejecting Claim 1, the Examiner admitted as much.

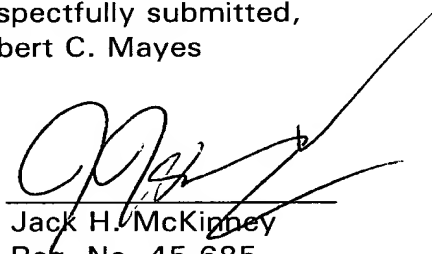
For these reasons, Claim 12 and Claims 13-15, 20, and 21, which depend from Claim 12, are felt to distinguish over the cited art

Conclusion

In view of the foregoing remarks and amendments, Applicant respectfully submits that claims 1-15, 20, and 21 define allowable subject matter. The Examiner is requested to indicate the allowability of all claims in the application and to pass the application to issue.

Respectfully submitted,
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By


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